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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,303	06/30/2000	Brian J. Hopkins	6707.US.O1	9823

23492 7590 05/10/2004

STEVEN F. WEINSTOCK
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

EXAMINER	
DEAK, LESLIE R	

ART UNIT	PAPER NUMBER
3762	

DATE MAILED: 05/10/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/608,303	Applicant(s) HOPKINS ET AL.	
	Examiner Leslie R. Deak	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13 and 15-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 June 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *15*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by US 1,366,789 to Graham. Graham discloses a liquid-receptacle attachment with receptacle engaging projections 17, 18, and 19 that are concentric, increasing in diameter from one another (column 2, lines 82-87, FIG 3). The third segment 19, includes a base 16 and annular wall 19. The engaging projections, optionally including a screw ring, are sized to engage a small, medium, or large-necked bottle, as needed (column 2, lines 60-67, FIGS 2-4). Furthermore, the attachment contains an outlet opening 22, from which fluid may flow into another container (column 2, lines 104-106, FIGS 3-4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 1,366,789 to Graham in view of US 4,614,437 to Buehler. Graham discloses the

apparatus as claimed with the exception of a spike located on the attachment. Buehler discloses a mixing container and adapter with annular openings capable of engaging bottles of two different diameters (FIGS 1, 3), and a cutting sleeve 34 with an angled tip 36 for pierce seals of containers to permit mixing therebetween (column 4, lines 38-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to add a spike for piercing containers to allow mixing, as disclosed by Buehler, to the three-size attachment disclosed by Graham in order to permit mixing between sealed containers.

5. Claims 13 and 15-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 1,366,789 to Graham in view of US 4,614,437 to Buehler as in paragraph 4 above, in view of US 4,010,756 to DuMont et al. The modified Graham device discloses the apparatus as claimed, but does not disclose a weakened portion for breaking away the spike or needle. Break-away needles are well-known in the art, and providing a weakened portion of the needle aids in breaking the needle. DuMont discloses a needle with a weakened zone 4b to facilitate the breakage of the needle at the weakened zone (column 2, lines 41-42, 55-58, FIG 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a weakened zone as disclosed by DuMont in the needle of the modified Graham attachment in order to facilitate easy needle breakage at a precise location, as taught by DuMont.

Response to Arguments

6. Applicant's arguments filed 2 March 2004 have been fully considered but they are not persuasive. In response to applicant's argument that Graham fails to disclose "one outlet for allowing residual liquid" that permits fluid flow from segment to segment in the connector, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. While Graham fails to disclose a trans-segment outlet, applicant has failed to positively claim an opening that traverses the segments in the connector. Applicant's language simply recites that the outlet is "for" a particular purpose, which fails to set forth any structural limitations that establish the outlet as a trans-segmental passageway. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

7. Furthermore, the functional recitation that the opening in the claimed invention allows the residual fluid to flow from segment to segment has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

8. In response to applicant's argument that DuMont is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the

DuMont reference served to overcome the particular problem of providing a spike or needle that may be easily and quickly detached from supporting apparatus. DuMont, like the applicant, overcame the problem of detaching the needle or spike by providing a weakened portion of the needle or spike for an easy detachment point. Therefore, the applied art is appropriate and is, in fact, analogous to the problem at hand.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 703-305-0200. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lrd
3 May 2004

ANGELA D. SYKES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700